

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In Re Application of: Blocher et al.

Art Unit: 3629

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Dkt. #: END920010013US1 (IBME-0017)

Cust. No.: 23550

Examiner: Brooks, Matthew L.

Title: **BUSINESS PROCESS CONTROL POINT TEMPLATE AND METHOD**

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants respectfully request a panel of experienced examiners perform a detailed review of appealable issues for the above-identified patent application pursuant to the Pre-Appeal Brief Conference Pilot Program. Applicants submit that the above-identified application is not in condition for appeal because the Office has failed to establish a prima facie case of obviousness based on an error in facts. Claims 1-2 and 4-30 are pending in this application.

Turning to the rejections, in the Office Action, claims 1-30 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over the public activities of Keane Inc. as of May 5th, 2000 as shown by their web Homepage as of said date and "PRAM it or walk away"; Gray, Neal; Transactions of AACE International; pp. r5-48; 1988, collectively one reference ("PRAM"). Office Action, p. 4. In support of its rejection, the Office asserts that the PRAM reference discloses all of the elements of claims 1 and 7-10 *except* the claim limitation that there is a separate template for each control point. The Office attempts to cure this deficiency with a

general statement that “when the prior art teaches all of the limitations except for making separable the steps of components the application’s claims are held to be obvious.” Office Action, p. 5. In support of this statement, the Office cites to *In re. Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). This case is distinguishable from the present case and does not provide the proper support for the Office’s rejection. As indicated by the Office, that case involved a lipstick holder with a removable cap, that was held to be met by the prior art when in the prior art, the cap was press fit and therefore not manually removable. In contrast, in the present case, it is not merely a question of separating out two elements that are already in the prior art. As argued in the After-Final Amendment filed February 20, 2007, the Office’s attempt to add an element to the prior art without proper support is improper. The fact remains that the PRAM reference does not disclose providing a separate template for each control point. This claim limitation is simply not present in the PRAM reference, and it is not enough for the Office to simply state that it would be obvious to add it in.

Specifically, as argued in the After-Final Amendment, pp 14-15, Applicants submit that the PRAM reference, either singly or in combination with the Office’s Official Notice, fails to disclose, *inter alia*, the step of “arranging information pertaining to the control points in a standard format using a separate template for each control point and storing the template in a computer database to provide subsequent access to the template . . .” (*See* claim 1, and as similarly recited by claims 7, 10, 12, 16, 19, 23, 26, and 28.) The Office’s Official Notice fails to cure this deficiency.

Applicants submit that the PRAM reference discloses a risk profile (Fig. 3) with all the key risks on one page. PRAM reference, page C, section V. As shown in Figure 3 of the PRAM reference, each risk variable (Stable Specs, SME’s Available as Scheduled, etc.) is listed in the

same profile/template. In contrast, the present invention claims, *inter alia*, a method for reviewing a business process that includes a separate template for each control point for arranging business process review information.

Furthermore, Applicants submit that the PRAM reference does not disclose several other features of the claimed invention, in addition to the “separate template” element discussed above. For example, as argued in the August 28, 2006 Amendment, Applicants argue that the PRAM reference does not disclose a template to identify whether the risk has actually occurred. The PRAM reference discloses:

“[o]nce the initial estimates exist, the estimator must make a list of all risks for the task, project, job, or proposal that is being addressed. Listen for words and phrases including, ‘That’s an issue,’ ‘I don’t know,’ ‘We assume,’ ‘I’m not sure,’ ‘I think,’ ‘I have no idea,’ or ‘We’ll figure it out as we go.’ These are a few tell-tale phrases that indicate the potential for risk.” (*See* the PRAM reference, section V.)

According to the above passage, the PRAM reference discloses a method of risk identification based on verbal communication(s) between the customer and the estimator. *Id.* Depending on the words/phrases used by the customer, the risks are identified and listed in the template. *See* Fig. 3 of the PRAM reference. However, the template in Fig. 3 does not contain, list, or arrange any of the methods/tests used by the estimator and the client to identify a specific occurrence of a risk. For example, Fig. 3 of the PRAM reference makes no disclosure of a column or metric for displaying the various verbal communication clues used by the estimator to identify risks. As such, various estimators may reach inconsistent results by using different methods of identification. These problems are magnified for a new estimator or an external estimator unfamiliar with the verbal communication method of risk identification taught by the PRAM reference.

In contrast, as discussed above, the present invention discloses, *inter alia*, a method for reviewing a business process that includes a standard template for arranging business process review information, wherein the information includes a set of tests to be performed by a test entity in a test field. This allows all review information for a particular control point to be arranged in a separate template and stored so that reviewers, auditors or the like can refer to the template to accurately and efficiently perform their duties. The PRAM reference fails to disclose this claimed feature. Even assuming, *arguendo*, that the PRAM reference discloses generally a template for identifying risks, Applicants submit that the PRAM reference does not disclose a template to identify whether the risk has actually occurred. Accordingly, Applicants submit that the PRAM reference fails to disclose each and every element of claim 1.

Furthermore, Applicants submit that the PRAM reference, which fails to disclose each and every feature of the claimed invention, may not be bolstered simply by a recitation of the general business services provided by Keane Inc. The nature of Keane Inc.'s business may not be used to supplement an element absent from the PRAM reference. Unless each and every element of Applicants claim 1 is taught by the PRAM reference, the rejection is improper. As discussed above, nowhere does the PRAM reference disclose, *inter alia*, arranging information pertaining to the control points in a standard format using a separate template for each control point and storing the templates in a computer database to provide subsequent access to the template, wherein the information comprises the set of tests to identify an occurrence of the risks in the business process. Therefore, the Office's rejections based on the PRAM reference are improper and without factual support.


Finally, with regard to the 35 U.S.C. §103(a) rejection of claims 27 and 30 over the PRAM reference and further in view of Official Notice, Applicants assert that the Office's

factual assertion is not properly based upon common knowledge. For example, Applicants assert that a computer implemented template comprising an information access field for arranging background information, wherein the information access field includes at least one hypertext link that allows direct access to the background information is not obvious to one skilled in the art as asserted by the Office. Because the Office has not supported its rejection with references that show these features, Applicants submit that this rejection is improper.

With respect to independent claims 7, 10, 12, 16, 19, 23, 26, and 28, Applicants herein incorporate the arguments made above with respect to claim 1. With respect to dependent claims 2, 4-6, 8-9, 11, 13-15, 17-18, 20-22, 24-25, 27, and 29-30, Applicants herein incorporate the arguments presented above with respect to the independent claims from which the claims depend. The dependent claims are believed to be allowable based on the above arguments, as well as for their own additional features.

Applicants respectfully submit that the application is not in condition for appeal. Should the examining panel believe that anything further is necessary to place the application in better condition for allowance or for appeal, they are requested to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



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